REMARKS

In the Office Action mailed February5, 2008, the Examiner objects to the specification, figure 1 and claims 14, 22 and 23 based upon informalities. The Examiner rejects claims 14 through 18, 20 through 23, 32, 41, 42 and 45 through 49 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 through 15, 17, 19 through 21, 24 through 27, 34 through 36, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,169,542 to Hooks, et al. ("Hooks"). Claim 16 stands rejected under 35 U.S.C. 103(a) as obvious over Hooks in view of US Patent Publication No. 2003/0130887 to Nathaniel ("Nathaniel") and further in view of US Patent Publication No. 2002/01601609 to Zizzamia, et al. ("Zizzamia"). Claims 18, 22 and 23 stand rejected under 35 U.S.C. 103(a) as obvious over Hooks in view of US Patent Publication No. 2002/0087980 to Eldering, et al. ("Eldering"). Claims 28 through 31, 33, 37 through 41, 43 through 49, 52 and 53 stand rejected under 35 U.S.C. 103(a) as obvious over Hooks in view of US Patent No. 6,941,573 to Cowan, et al. ("Cowan"). Claims 32 and 41 stand rejected under 35 U.S.C. 103(a) as obvious over Hooks in view of US Patent Publication No. 2003/0154128 to Liga, et al. ("Liga").

Claims 1 through 53 are currently pending in the present application, with claims 1, 24, 34, 43, 45, 49 and 50 being independent claims. By way of the present Response, Applicants hereby amend claims 1, 14, 16 through 18, 20 through 23, 32, 41, 42, 45, 49, 50, 52 and 53 and cancel claims 13 and 51. No new matter has been added and the amendments are supported by the specification as originally filed. For at least the reasons set forth below, Applicants respectfully submit that all pending claims are

allowable and respectfully request withdrawal of the rejection of claims 1 through 12, 14 through 50, 52 and 53.

The Examiner objects to figure 1 on the basis of an informality, specifically reference characters "114" and "134", as both are being used to designate the NDVR control center. Accordingly, the Examiner requires new corrected drawings in compliance with 37 CFR 1.1.21(d). In response, Applicants submit replacement figure 1, removing the reference character "114". In view thereof, withdrawal of the objection is respectfully requested.

In addition to the foregoing objection, the Examiner objects to the specification based upon a number of informalities. Applicants respond in part by hereby amending the specification in accordance with the Examiner-noted informalities. Specifically, Applicants (i) amend paragraph 12 in order to clarify the ambiguity between the acronyms AMS and ADM and (ii) amend paragraphs 43 and 57 in order to remove reference to reference character "114" of figure 1.

Applicants further respond to the Examiner's objection regarding the specification improperly containing an embedded hyperlink and/or other form of browser executable code under MPEP § 608.01 by respectfully traversing Examiner's objection. MPEP § 608.01 VII states in pertinent part:

> Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "< >" and http:// followed by a URL address. When a patent application with embedded hyperlinks and/or other forms of browser-executable code issues as a patent (or is published as a patent application publication) and the patent document is placed on the USPTO web page, when the patent document is retrieved and viewed via a web browser, the URL is interpreted as a valid HTML code and it becomes a live web link. When a user clicks on the link with a mouse, the user will be transferred to another web page identified by the URL, if it exists, which could be a commercial web site. USPTO policy does not permit the

> USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views or accuracy of the information contained on these outside sites.

Appendix A attached to the Specification presents a textual XML description of the tree view diagram illustrated in figure 16. Appendix A is not an example of a hyperlink or a browser-executable code, as the MPEP states that an example would be a URL address, that when clicked would link to a web page. Furthermore, assuming *arguendo* that Appendix A contain a hyperlink or a browser-executable code, MPEP § 608.01 VII further states that,

> Where the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks.

Accordingly, under MPEP § 608.01 VII, the Examiner's objection is improper as Appendix A does not constitute an embedded hyperlink and/or other form of browser executable code, and in the event that the Examiner maintains that Appendix A does constitute browser executable code, Applicants do not intend to have Appendix A be active links to other remote content as part of the present Application, but instead assert that content of Appendix A is part of present Application. In view thereof, withdrawal of the objection regarding the specification improperly containing an embedded hyperlink and/or other form of browser executable code under MPEP § 608.01 is respectfully requested.

The Examiner further objects to claims 14, 22 and 23 based upon a number of informalities. Applicants respond by hereby amending claims 14, 22 and 23 in

accordance with the Examiner-noted informalities. In view thereof, withdrawal of the objections is respectfully requested.

Claims 14 through 18, 20 through 23, 32, 41, 42 and 45 through 49 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 14, the Examiner asserts that the element "the system of claim 14" lacks sufficient antecedent basis. By way of the present Amendment, Applicants have amended claim 14 to recite that dependency stems from claim 13 in order to overcome the Examiner's objection to claim 14. The Examiner further asserts that the limitation "the group" in claim 16, the limitation "the set" in claims 32 and 41 and the limitation "the basis" in claims 45 and 49, lacks sufficient antecedent basis. Applicants hereby amend claims 16, 32, 41, 45 and 49 in order to provide proper antecedent basis. The Examiner further asserts that the element of "the ADM" in claims 17, 18, 20 through 23 and 42 lacks sufficient antecedent basis. Applicants hereby amend claims 17, 18, 20 through 23 and 42 in order to remove reference to the term "the ADM" and replace with the claim limitation "the AMS", and have amended paragraph 12 of the specification to clarify that the terms AMS and ADM are interchangeable in order to obviate any confusion. In view thereof, withdrawal of the rejection of claims 14 through 18, 20 through 23, 32, 41, 42 and 45 through 49 under 35 U.S.C. 112, second paragraph, is respectfully requested.

Claims 1 through 15, 17, 19 through 21, 24 through 27, 34 through 36, 50 and 51 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hooks. Applicants

respectfully disagree because, as described in further detail below, Hooks fails to identically disclose all of the claimed elements recited herein.

Claim 1, as currently amended, is directed to a system for creating a program for delivery to a client in a video time shifting architecture. The system comprises an advertisement selection system (ADS) operative to select one or more advertisements according to a targeted algorithm and transmit one or more identifiers that uniquely identify the selected advertisements, an advertisement management system (AMS) operative to generate a playlist that identifies content, including a user requested time shifted program and the one or more selected advertisements and a video server operative to interpret the playlist and deliver the content to the user.

Hooks discusses an interactive video distribution system that includes multiple subscriber units 22. The head end facility 54 generates a multi-media presentation, e.g. a television show, which includes an advertising segment. Hooks discusses the integration of a "first advertisement 40" and a "second advertisement 42" that are inserted into the "full motion program 36." (Hooks, Col. 4, lines 54-65). The ads are transmitted during an advertisement break 43 of the full motion program 36. (Hooks, Col. 4, lines 60-65). The interactive video subscriber units 22 include the set-top box 94 coupled to the video distribution mechanism 56. (Hooks, Col. 7, lines 59-63). Through user interaction, the user can select to request additional information during one of the advertisements. An example of this is Fig. 4 illustrating the "i" logo 108 on the screen, which indicates the ad as being interactive and allowing a user to register the ad in the advertisement menu 92. The menu is "customized for the specific subscriber in response to the subscriber's registration request." (Hooks, col. 9, lines 46-47). As illustrated in

the flowchart of Fig. 7, the subscriber may then be presented with the follow-up information, such as the exemplary interactive menu of Fig. 9. Thus, the user can then interact with the follow-up information based on an original selection of the earlier interactive advertisement.

Hooks fails to disclose each and every element of independent claim 1, specifically "an advertisement selection system (ADS) operative to select one or more advertisements according to a targeting algorithm . . .". In support of the rejection of dependent claim 13, which by way of the present Response has been incorporated into independent claim 1, the Examiner asserts that Hooks' description of an "editing facility 28 [that] generates advertisements or receives pre-recorded advertisements which are inserted into the original program during predetermined breaks in the original program" (Hooks, Col. 4, lines 9-12) discloses the selection of advertisement according to a targeting algorithm. However, the Examiner's reliance upon the specific portion of Hooks' disclosure fails to disclose the claimed element of an ADS "operative to select one or more advertisements according to a targeting algorithm." The method of simply inserting advertisements into a program does not disclose the selection of such advertisements, and the process by which the selection is accomplished, namely by utilizing a targeting algorithm, as claimed in the present Application. Accordingly, on the basis of the foregoing, Applicants respectfully assert that pending independent claim 1 is allowable over Hooks and request allowance regarding the same.

Claim 24 is directed to a method for delivering local advertising to a client in a video distribution system. The method comprises performing an action that invokes a request for a program and collecting information regarding the request. A playlist

utilizing a correctly zoned local advertisement and the requested program is generated and the correctly zoned local advertising and program is delivered to a client for decoding and playback. Independent claim 34, which is directed to a system, comprises substantially similar elements to those comprising independent claim 24.

Hooks fails to disclose each and every limitation of independent claim 24, specifically "generating a playlist utilizing a correctly zoned local advertisement and the requested program." In support of the rejection, the Examiner asserts that Hooks' description of a method step for "generating an entry for the advertisement in the menu" (Hooks, Col. 2, lines 44-45) discloses the claimed step of generating a playlist that utilizes a correctly zoned local advertisement. However, a generated menu entry is simply not the equivalent of a playlist that includes a correctly zoned local advertisement, as a menu entry simply contains a listing of an advertisement while the playlist of the presently claimed invention contains both a program and a correctly zoned local advertisement that is ultimately delivered to an end user. Furthermore, Hooks fails to disclose or even suggest advertisements limited to a correct local zone. At best, Hooks discloses a method to deliver advertising without disclosing that the type of advertisements are locally zoned advertisements and without disclosing the steps to deliver such specific advertisements. Accordingly, Applicants respectfully assert that pending independent claims 24 and 34 are allowable over Hooks and request allowance regarding the same.

Claim 50, as currently amended, is directed to a method for delivering local advertising to a client in a video distribution system. The method comprises receiving a playlist identifying programming and advertising information and

transmitting video data identified in the playlist to a client operative to decode and display the video data. A control command is received from the client and the playlist is modified in accordance with the control command, wherein the advertising information identified in the playlist is updated. Video data identified in the modified playlist is transmitted to the client.

Hooks fails to disclose each and every element of independent claim 50, specifically "modifying the playlist in accordance with the control command, wherein the advertising information identified in the playlist is updated." In support of the rejection of claim 51, which by way of the present Amendment has been incorporated into the claimed element of independent claim 50, the Examiner asserts that Hooks' discussion of an "editing facility 28 [that] generates advertisements or receives pre-recorded advertisements which are inserted into the original program during predetermined breaks in the original program" (Hooks, Col. 4, lines 9-12) discloses the claimed element. However, generating an advertisement and inserting it into a program is not the equivalent of updating advertising information in a playlist as a result of the receipt of a control command received from the client, as generating an advertisement and inserting it into a program involves only sending the advertisement to client, it does not account for client interaction that results in an update process of advertisement information. Hooks simply fails to disclose the update of advertising information resulting from a client interaction. Accordingly, Applicants respectfully assert that pending independent claim 50 is allowable over Hooks and request allowance regarding the same.

Claims 28 through 31, 33, 37 through 41, 43 through 49, 52 and 53 stand rejected under 35 U.S.C. 103(a) as obvious over Hooks in view of Cowan. Independent

claim 43 is directed to a method for delivering local advertising to a client in a video distribution system. The method comprises receiving multiple zoned copies of a given program, each zoned copy containing proper local advertising for a given zone, recording a properly zoned copy of a given program for each zone the video distribution system services, determining the zone in which the client requesting a program is located and transmitting a properly zoned copy of the requested program to the client.

Independent claim 45 is also directed to a method for delivering local advertising to a client in a video distribution system and recites the claimed elements of determining the zone in which a requesting client resides and adding identifiers for one or more local advertisements to the playlist based on the determined zone. Claim 49 is also directed to a method for delivering local advertising to a client in a video distribution system, which recites the claimed elements of receiving a copy of a given program for each zone that the video distribution system services, segmenting the program into program content, national advertising and local advertising and retaining the program content and discarding the national and local advertising. The method of claim 49 further recites receiving a request for the program from a client in a given zone, creating a playlist identifying the programming content, calculating the program advertising zone in which the requesting client resides and adding identifiers for advertising to the playlist based on the zone in which the client resides.

The Examiner concedes that the Hooks fails to teach or suggest the elements of independent claim 43, 45 and 49 relating to zones. Instead the Examiner relies upon Cowan in support of all claim elements of independent claims 43, 45 and 49 relating to zones. Specifically, the Examiner relies upon Cowan's discussion of

substitute advertising that can "be determined by comparing consumer purchase data collected from selected stores associated with zones receiving the substitute advertising with consumer data collected from selected stores associated with zones receiving normal advertising." (Cowan, Col. 4, lines 35-40). Cowan, however, does not teach or suggest any of the claim elements of independent claims 43, 45 or 49. For example, Cowan fails to teach or suggest "receiving multiple zoned copies of a given program, each zoned copy containing proper local advertising for a given zone", "recording a properly zoned copy of a given program for each zone the video distribution system services", "determining the zone in which the client requesting a program is located" or "transmitting a properly zoned copy of the requested program to the client."

Cowan's disclosure of a comparison of purchase data from stores in different zones is simply not analogous to the receipt and subsequent recording of different versions of a given video program according to a zone, nor is it analogous to a determination of a zone or area of where a requesting client is located and subsequently transmitting a video program to that zone. Similarly, Cowan's disclosure fails to teach or suggest the claim elements recited in independent claims 45 and 49 relating to video programming with respect to zones. Cowan solely teaches or suggests a comparison of purchase data collected from selected stored that are to be representative of a geographic zone.

A comparison of purchase data is in no way related to the claimed method of delivering local zoned advertising. Specifically, Cowan's data relates to the purchase activity of consumers at selected stores that is subsequently compared in order to determine substitute advertising, while the presently claimed invention is directed to

creating a play list that contains a program and specific advertising content based upon the zone in which the client is located. At best, Cowan is directed to a comparison of consumer purchase data, which fails to teach or suggest any of the elements of independent claims 43, 45 or 49 regarding video programming with respect to zones. Accordingly, Applicants respectfully assert that pending independent claim 43, 45 and 49 are allowable over Hooks and Cowan, and request allowance regarding the same.

The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over Hooks, Cowan and the prior art of record. Given the Applicants' position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

For at least all of the above reasons, Applicants respectfully request that the Examiner withdraw all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicants' undersigned representative to discuss any issues relating to this application.

Respectfully submitted,

Date: June 5, 2008

THIS CORRESPONDENCE IS BEING SUBMITTED ELECTRONICALLY THROUGH THE PATENT AND TRADEMARK OFFICE EFS FILING SYSTEM ON JUNE 5, 2008.

Jeanpierre J. Giuliano
Reg. No. 55,206
DREIER LLP
499 Park Avenue
New York, New York 10022
Tel : (212) 328-6100
Fax: (212) 328-6101

Customer No. 61834